

GP 1615 D.A.C

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants : Eek et al. **RECEIVED**  
Serial No. : 09/463,920 **DEC 28 2000**  
Filed : February 1, 2000 **TECH CENTER 1600/2300**  
For : NEW PHARMACEUTICAL FORMULATION  
Examiner : S. Tran  
Group Art Unit : 1615



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Assistant Commissioner for Patents  
Washington, D.C. 20231.

John M. Genova 32,224  
Attorney Name PTO Reg. No.

John M. Genova 20 December 2000  
Signature Date of Signature

Assistant Commissioner for Patents  
Washington, D.C. 20231

**PETITION FOR WITHDRAWAL OF  
PREMATURE OFFICE ACTION**

Sir:

This Petition is in response to the Office Action, mailed November 29, 2000. Applicants respectfully submit that the Office Action is premature for the reasons discussed below.

Withdrawal of the premature Office Action is therefore requested.

## REMARKS

The referenced application was filed pursuant to 37 C.F.R. §371 and is the designated U.S. family member of International Application No. PCT/SE99/02315, filed December 10, 1999 (the "PCT application"). The PCT application claims priority to a Swedish priority date of December 14, 1998. As evidence by the Transmittal Letter to the United States Designated Office (DO/US) that accompanied the referenced application, filed February 1, 2000, Applicants expressly indicated that United States national stage processing of the PCT application may commence at the expiration of the applicable time limit under PCT Articles 22 and 39(1) pursuant to the provisions of 35 U.S.C. §371(b).

A Notification of Acceptance of Application under 35 U.S.C. §371 and 37 C.F.R. §1.494 or 1.495 (Form PCT/DO/EO/903) was mailed May 11, 2000. A Demand was received by the IPEA on June 22, 2000 i.e., with 19 months of the priority date of December 14, 1998. On November 29, 2000, a first Office Action was issued.

PCT Article 40 provides the following:

### Delaying of National Examination and Other Processing

(1) If the election of any Contracting State has been effected prior to the expiration of the 19<sup>th</sup> month from the priority date, the provisions of Article 23 shall not apply to such State and the national Office of or acting for the State shall not proceed, subject to the provisions of paragraph (2), to the examination and other processing of the international application prior to the applicable time limit under Article 39.

(2) Notwithstanding the provisions of paragraph (1), any elected Office may, on the express request of the applicant, proceed to the examination and other processing of the international application at any time.

Pursuant to PCT Article 40, the national Office of the Contracting State will not proceed to the examination and other processing of the international application prior to the expiration of

the applicable time limit under Article 39 unless expressly requested by the applicant. The time limits under PCT Article 39 is 30 months from the earliest claimed priority date, December 14, 1998.

Since the Demand, with the U.S. being elected, was filed before the expiration of the 19<sup>th</sup> month from the earliest priority date and there was no request made under the PCT Article 40(2) for an early examination, examination of the referenced application may not commence until the 30 month time limit under PCT Article 39 has expired. Specifically, examination must not begin before June 14, 2001.

Because the first Office Action of November 19, 2000 was issued before the expiration of the time limit under PCT Article 39, it is an improper action pursuant to PCT Article 40 and should be vacated.

No fee should be due in connection with this communication. However, should it be deemed that a fee is required for any reason, the Assistant Commissioner is hereby authorized to charge it to Deposit Account No. 23-1703.

Dated: December 20, 2000

Respectfully submitted,



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